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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,101	10/11/2001	Michael J. Goldberg	6954-1	8764

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EXAMINER

BUI, LUAN KIM

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,101

Applicant(s)

GOLDBERG, MICHAEL J.

Examiner

Luan K Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16, 17 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-14, 16, 17, 19, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continued Prosecution Application

1. The Request for Continued Examination (RCE) filed on 2/20/2004 under 37 CFR 1.114 based on parent Application No. 09/975,101 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8-14, 16, 17, 19, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 8 and 21, the phrase "an removable applicator" is incomplete and indefinite. It should be --a removable applicator--. In claim 8, line 7, the phrase "second end of said;" [sic] is incomplete and indefinite. The phrases "said removable applicator is secured to said sleeve opening by an adhesive" in claim 12 and "said removable applicator is permanently secure to said sleeve opening" in claim 14 are confusion and indefinite because the independent claim 8 recites "a removable applicator" but the dependent claims 12 and 14 recite the applicator is permanently attached to the sleeve.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 8, 13 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Benson (3,983,914). Benson discloses a bag/cover comprising a flexible sleeve (8) having a top wall, a bottom wall, two side walls connecting the top wall and the bottom wall, a rear wall at a first end of the sleeve and a sleeve opening defined by the top wall, the bottom wall and the two side walls at a second end of the sleeve, and a removable applicator (1) comprising a tubular member having a first end and a second end with the first end is secured to the sleeve opening (Figure 2). The sleeve of Benson is inherently capable of enveloping a hand-held electronic device.

6. Claims 8-10, 12, 14, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Young et al. (6,345,911; hereinafter Young'911). To the extent that the Examiner can determine the scope of the combination claims 8, 12 and 14, Young'911 discloses a bag/cover (10) comprising a flexible sleeve (12) having a top wall, a bottom wall, two side walls connecting the top wall and the bottom wall, a rear wall at a first end of the sleeve and a sleeve opening (16) defined by the top wall, the bottom wall and the two side walls at a second end of the sleeve, and an applicator (14, 15) comprising a tubular member having a first end and a second end with the first end is permanently secured to the sleeve opening by adhesive or the like (Figures 1-3). The sleeve of Young'911 is inherently capable of enveloping a hand-held electronic device and allowing the electronic device to be selectively removed from the sleeve.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffer (5,499,713). Huffer discloses a transparent cover (10) for an electronic device comprising a flexible sleeve (12) having an opening in at least one end thereof for receiving an electronic device (14) and allowing the device to be selectively removed from the sleeve and a means (24) for applying the flexible sleeve onto the electronic device. To the extent that Huffer fails to disclose the means for applying the flexible sleeve onto the electronic device, it would have been obvious to one having ordinary skill in the art in view of Huffer to hold the closing web on one hand and applying the sleeve onto the electronic device to facilitate applying the sleeve onto the electronic device.

9. Claims 9-11, 16, 17, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 8 above, and further in view of Official Notice. Benson fails to show the sleeve being formed from a transparent plastic and the sleeve opening comprises a pressure sensitive adhesive on an inner periphery of the sleeve opening for sealing the sleeve opening. Official Notice is taken of the old and conventional practice of providing a bag formed from a transparent plastic and a pressure sensitive adhesive on an inner periphery of a bag opening for sealing the bag opening. It would have been obvious to one having ordinary

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skill in the art in view of Official Notice to modify the sleeve of Benson so the sleeve is formed from a transparent plastic to allow visual access to the contents within the sleeve and the sleeve opening includes a pressure sensitive adhesive on an inner periphery of the sleeve opening to facilitate sealing the sleeve opening.

Allowable Subject Matter

10. Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

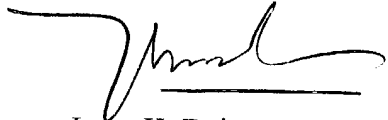
Applicant's arguments with respect to all pending claims have been considered but are deemed to be moot in view of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (703) 305-5861. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to TC 3700 Customer Service at (703) 306-5648.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 872-9301. Facsimile correspondence for this application should be sent to (703) 872-9306 for Formal papers and After Final communications.

lkb
March 29, 2004


Luan K. Bui
Primary Examiner